

## **REMARKS**

The Examiner rejected Claims 6, 9, 10, 11, and 14 under 35 U.S.C. § 102(b) as being anticipated by Patent Number 5,608,196 (Hall). The Examiner rejected Claims 1, 4, and 5 under 35 U.S.C. § 103(a) as being unpatentable over Patent Number 2,096,503 (Allread) in view of Hall. Such rejections are noted. The Examiner objected to a typographical error in the Specification. Such Objection is noted.

Claims 11 and 14 are cancelled, without prejudice and Applicants respectfully submit that Claims 1, 4-6, and 9-10 are allowable for the following reasons.

### **Record of Telephone Interview**

On February 8, 2007, Applicants' attorney, Thomas A. Kulaga, spoke with the Examiner during a telephonic interview. Mr. Kulaga discussed independent Claims 1, 6, 11 and the rejection of those claims as being anticipated by Hall because the Examiner asserts that the DIP switch in Hall is the same as a terminal block included in the claims. Mr. Kulaga identified Patent Number 4,332,987 that discloses a DIP switch and Patent Number 4,810,212 that discloses a terminal block. Mr. Kulaga pointed out that those skilled in the art recognize that a DIP switch has leads that are soldered to a printed circuit board and has no provision for releaseably connecting or terminating wires such as accomplished with a terminal block. Mr. Kulaga pointed out that the two patents disclose different components that perform different functions.

The Examiner pointed out that the claims use the introductory phrase "adapted to" and the Examiner considered those clauses to not be limitations. Without the structure following the "adapted to" phrase, the Examiner asserts that there is no difference between a DIP switch and a terminal block. Mr. Kulaga pointed out that the holding of the 1946 case, *In re Hutchinson*, relied upon by the Examiner does not really support ignoring clauses using the phrase in the present case. He pointed out that MPEP 2111.04 addresses the use of the phrase "adapted to" in claims. The MEPEP states that whether clauses beginning with "adapted to" "is a limitation in a claim depend on the specific facts of the case." MPEP 2111.04, at 2100-46, 8th ed., Rev. 5.

The Examiner suggested that changing the word "adapted" to "configured" would include the structural limitations in the claims. The Examiner also objected to the word "whereby" as introducing a clause that is to be ignored for determining patentability. The Examiner suggested changing the word "whereby" to "wherein." Mr. Kulaga asked if the Examiner would allow the claims if the claims were amended as suggested and were also amended to add a limitation more clearly defining the terminal block. The Examiner said she would have to perform another search and she said that Applicants would have to file an RCE for her to consider such changes.

Mr. Kulaga then discussed Claim 11, a mean plus function claim. He pointed out that the rejection of the claim did not address the structures corresponding to the functions as required by MPEP 2183. The Examiner was adamant that the prior art discloses the identical function and the claim limitations do not include any distinguishing structural limitations. The Examiner said that she could not read any structural limitations from the Specification when interpreting the claims. Mr. Kulaga pointed out that such a position was not in accordance with the MPEP and case law with respect to interpreting mean-plus-function limitations. Mr. Kulaga referred the Examiner to MPEP section 2183, which identifies several reasons that support rejecting a means-plus-function element.

### **Rejection Under 35 U.S.C. § 102(b)**

Addressing the rejection of Claims 6, 9, 10, 11, and 14 under 35 U.S.C. § 102(b), Applicant respectfully suggests that Hall does not anticipate the claims of the present invention. Section 2131 of the Manual of Patent Examining Procedure describes the basis for anticipation under 35 U.S.C. § 102(b). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

## **Claims 6, 9, and 10**

With respect to Claims 6, 9, and 10, Applicants incorporate by reference the arguments from their Response filed October 23, 2006. Further, Applicants offer the following to rebut the continued rejection of the claims.

The Final Office Action rejected Claim 6 on the basis that the DIP switch of Hall is the same as the claimed terminal block element. The Examiner states:

In response to applicant's arguments that the prior art teaches of dip switch, not a terminal block, examiner disagrees. The dip switch, item 28, provides multiple termination points, as is the function of a terminal block.

Paper Number 20061225, at 8. The Office Action has not provided any further reasoning for finding that the two disparate items, a DIP switch and a terminal block, are identical for finding anticipation.

Patent Number 4,332,987 discloses a DIP switch and Patent Number 4,810,212 discloses a terminal block. The DIP switch is a device that has its terminal leads soldered to a printed circuit board. A terminal block is a device that releaseably connects wires. A person having ordinary skill in the art at the time of invention would clearly understand the difference between a DIP switch and a terminal block and would also realize that the two components are not interchangeable. A DIP switch, which is illustrated in the '987 patent, does not have any provision for terminating wires or conductors as is required by the claim. Applicants respectfully submit that Hall does not disclose a terminal block making electrical connections at any voltage level, particularly a low voltage terminal block as required by the claim.

The Office Action points out that Claim 6 includes a clause beginning with the phrase "adapted to" and the clause was not considered to include any structural limitations that further defined the claimed invention. Paper Number 20061225, at 3.

In order to expedite the allowance of the present Application, Claim 6 has been amended to replace the word "adapted" with "configured." Applicants respectfully submit that such change does not change the meaning of the claim and that Applicants originally intended that the structural limitations introduced by the word "adapted" further define and limit the terminal block element. Claim 6 is also

amended to include the limitation that the "terminal block [has] terminations that releaseably connect conductors." Such amendment is not new matter and corresponds to the limitation in Claim 1 that the "low voltage terminal block [has] a plurality of terminals."

Applicants respectfully submit that Hall does not disclose each and every element of Claim 6, namely, Hall does not disclose a low voltage terminal block as required by the claim. Accordingly, Applicants respectfully request the Examiner withdraw the rejection of Claim 6 because the claim is in condition for allowance. Further, Applicants respectfully submit that Claims 9 and 10 are also in condition for allowance as depending from an allowable base claim.

#### **Claims 11 and 14**

Claims 11 and 14 include means-plus-function limitations, as defined by 35 U.S.C. § 112, sixth paragraph. A means-plus-function limitation must be interpreted to cover the corresponding structure, materials, or acts in the specification and "equivalents thereof." 35 U.S.C. § 112, sixth paragraph; *see also* MPEP § 2181. The Examiner "must apply 35 U.S.C. 112, sixth paragraph in appropriate cases, and give claims their broadest reasonable interpretation, **in light of and consistent with the written description of the invention in the application.**" MPEP 2181, sub-section I, pg. 2100-220, 8th ed., rev. 2 (emphasis added).

In order to expedite the allowance of the present Application, Applicants have cancelled Claims 11 and 14, without prejudice.

#### **Obviousness Under 35 U.S.C. § 103**

The Examiner rejected Claims 1, 4, and 5 under 35 U.S.C. § 103(a) as being unpatentable over Allread in view of Hall. A rejection under 35 U.S.C. § 103(a) must be supported by a *prima facie* case of obviousness. MPEP § 2142. "The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." MPEP § 2142, pg. 2100-121.

The first element in establishing a *prima facie* case of obviousness is that "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings." MPEP § 2143. The second element is that there must be a reasonable expectation of success. *Id.* The third element is that "the prior art reference (or references when combined) must teach or suggest all the claim limitations." *Id.* "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper); see MPEP § 2143.01.

#### **Claims 1, 4, and 5**

With respect to Claim 1, the Office Action asserts that Hall discloses "a low voltage terminal block (28 for example)." Paper Number 20061225, at 6. As stated above, Hall does not disclose a terminal block and item **28** is a DIP switch, which is not the same as, nor an equivalent of, a terminal block. The rejection relies upon Hall for the premise that the claimed low voltage terminal block is the same as a DIP switch. For the reasons stated above, Applicants respectfully submit that Hall does not disclose a low voltage terminal block. Further, Claim 1 requires "said low voltage terminal block having a plurality of terminals accessible from a front side of said face plate." Hall does not disclose a terminal block and the DIP switch disclosed in Hall does not have terminals accessible from a front side of the face plate because a DIP switch, by its nature, only has connections on its bottom that mate with the printed circuit board. Accordingly, Applicants respectfully submit that the third element of a *prima facie* case of obviousness has not been shown because the references do not disclose a low voltage terminal block having the claimed limitations.

In order to expedite the allowance of the present Application, Claim 1 has been amended to replace the word "adapted" with "configured" and the word "whereby" with "wherein." Additionally, Claim 5 has been amended to replace the word "whereby" with "wherein." Applicants respectfully submit that such changes do not change the

meaning of the claim and that Applicants originally intended that the structural limitations introduced by the word "adapted" and "whereby" be part of the claim.

### **Objection to Specification**

The Examiner objected to a typographical error in the numbering in Published Application Specification Paragraph 34. The item number **704** is replaced with number **702** for the face plate illustrated in FIG. 7.

### **Election/Restrictions**

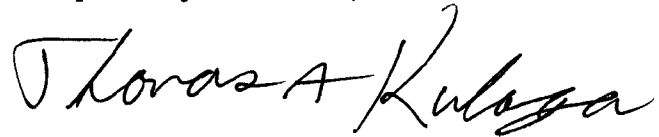
The Office Action requires that the claims withdrawn but traversed must be cancelled in order for a reply to be complete. In Paper Number 20060728, the Office Action includes the assertion that there is no allowable generic or linking claim. Applicants respectfully submit that independent Claims 1 and 6 are generic or linking claims to dependent Claims 2, 3, 7, and 8. Applicants further submit that when Claims 1 and 6 are found allowable, that all the claims depending from the independent claims are allowable. See MPEP 818.03(d), at 800-61, 8th ed., Rev. 5. Accordingly, Applicants continue their traverse of the restriction on the grounds that the independent claims are generic claims and that the dependent claims do not define independent and distinct inventions because the dependent claims only add limitations to the independent claims.

### **Conclusion**

In view of the amendment of Claims 1, 5, and 6 and the cancellation of Claims 11 and 14, without prejudice, it is believed that the above-identified patent application is in a condition for the issuance of a Notice of Allowance. Such action by the Examiner is respectfully requested. If, however, the Examiner is of the opinion that any of the drawings or other portions of the application are still not allowable, it will be appreciated if the Examiner will telephone the undersigned to expedite the prosecution of the application.

Please charge any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 50-3827 (05017-UPA).

Respectfully submitted,

A handwritten signature in black ink that reads "Thomas A. Kulaga". The signature is written in a cursive style with a large, stylized 'T' and 'K'.

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